

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested. Claims 1-11, 13-33, and 35-49 are pending. According to the Office Action, claims 1-45 are rejected. Please note that claims 12 and 34 were canceled in the August 3, 2003 response and claims 40-49 were added in the November 22, 2002 amendment. Thus, claims 1-11, 13-33, and 35-49 are pending. For purposes of clarity, claims 1-49 and the respective status of each claim is recited in this response. No new matter has been added.

Rejection of claims 1-11, 13-33 and 35-45 under 35 U.S.C. §103(a)

Claims 1-11, 13-33 and 35-45 stand rejected under 35 USC 103(a) as being unpatentable over US Patent 5,677,955 to Doggett *et al.* ("Doggett") and US Patent 5,897,625 to Gustin *et al.* ("Gustin"). Specifically, the Examiner asserts that:

Doggett discloses transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location (see Doggett, col. 2, lines 51-59); *as in at least claims 1, 24, 40 and 45*

--processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see Doggett, col. 3, ll. 19-30); *as in at least claims 1, 24, 40 and 45*

Gustin discloses receiving at a first location at least one of a check and cash having a front face and a back face (see Gustin, fig. 13, col. 12, ll. 5-53; and col. 15, ll. 45 to col. 16, ll. 28); *as in claims 1, 24, 40 and 45*

--scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash (see Gustin, figs. 13 & 14, col. 12, ll. 5 to col. 13, ll. 43; and col. 16, ll. 20-34);

processing a transaction at the second location with the scanned image of the deposited instrument or electronic validation of deposited cash, without verification of the signature of a user initiating the transaction in the case of a deposited instrument, which signature is used to verify that the user is a profiled user with a specified system, whereby pickup of said at least one of an instrument and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see col. 6, ll. 47 to col. 7, ll. 13); *as in claims 1, 24, 40 and 45.*

In view of Gustin's teaching, it would have been obvious for an artisan at the time the invention was made to employ and/or integrate into Doggett a scanner

with the ability to scan both sides of a check because an artisan at the time of the invention would recognize the fact that check (paper checks or cash) have writing and information on both sides of the financial instrument, and thus to scan both sides of the financial instrument would allow the system to store and/or transmit an accurate image. Thus to provide such a modification would be an obvious expedient well within the ordinary skill in the art.

On the other hand, Since Gustin provides a banking network via modem to perform transaction (See Gustin, col. 9, ll. 9-50). it would have been obvious to an artisan at the time the invention was made to provide alternative (such as the Internet) as disclosed in Doggett as an obvious extension of Gustin to perform various transactions between the parties (see Doggett, fig. 3, col. 7, ll. 39 to col. 8, ll. 32). Thus such a modification would have been well within the ordinary skill in the art as well as an obvious expedient.

The undersigned representative respectfully traverses the rejection of the above identified claims under 35 U.S.C. § 103(a) as being unpatentable over Doggett and Gustin in view of each other. The combination of Doggett and Gustin does not establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Doggett and Gustin, neither alone nor in combination, teach or suggest all the claim limitations.

Neither Doggett nor Gustin teach or suggest "processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash" as recited in claim 1 and similarly recited in claims 24, 40, and 45 (emphasis added). On pages 2-3 of the Office Action, the Examiner asserts that column 3, lines 19-30 of Doggett discloses this element. The cited section recites:

The electronic instrument may be delivered electronically to the institution at least in part via a publicly accessible data communication medium. At the institution, the signature of the payer and certificate may be verified in connection with transmitting funds to the payee. An account number may be included in the electronic instrument. The account may be a deposit account or a credit account. The instrument may be an electronic substitute check, a traveler's check, a

certified check, a cashier's check, or a credit card charge slip. The publicly accessible data communication medium may be unsecured. The institution may be a bank.

Doggett, col. 3, lines 19-30. The electronic instrument in Doggett is not "a scanned image of the deposited check or electronic validation of deposited cash" as recited in claim 1 and similarly recited in claims 24, 40, and 45 of the present application. In Doggett, a payer electronically creates a financial instrument, e.g., an electronic check. Doggett, col. 7, ll. 59-57. An electronic check is not the same as a scanned check or cash. Thus, Doggett does teach or suggest "processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash" as recited in claim 1 and similarly recited in claims 24, 40, and 45 (emphasis added). The Examiner does not cite Gustin as teaching or suggesting this element.

Moreover, neither Doggett nor Gustin teach or suggest "transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location" as recited in claim 1 and similarly recited in claims 24, 40, and 45 of the present application (emphasis added). Since Doggett does not scan a deposited check or electronic validation of deposited cash (as stated above), Doggett cannot transmit an image of either one. The Examiner asserts that column 2, lines 51-59 discloses this element. This cited section is in the background section of Doggett and is non-enabling. The Examiner does not cite Gustin as teaching or suggesting this element.

Moreover, neither Doggett nor Gustin teach or suggest "scanning the front face and back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash ... processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash" as recited in claim 1 and similarly recited in claims 24, 40, and 45 of the present application. The Examiner asserts that Gustin discloses scanning the check or cash and that Doggett discloses processing the transaction with the scanned image. Although Gustin scans checks or cash, Gustin does not transmit the scanned images of either for processing. As recited in Gustin, "the strings representing the signature verification as well as the amount on the document are forwarded to the bank network by the modem 29 for confirmation of payout." (Gustin, col. 13, ll. 43-47). Thus, Gustin is not transmitting the image of the check for processing but only transmits strings representing the

signature verification and the amount on the document. As for the cash aspect of the claims, Gustin discloses that “The preferred cash acceptor module 62 merely stacks the inserted bills and counts the same.... The deposit transaction proceed from the flow chart of FIG. 13H back to the flow chart of FIG. 13 to proceed through the modem and banking methods to make the deposit into the user’s checking or savings account.” (Gustin, col.16, ll. 4-17). Thus, the image of the cash is not being transmitted. Thus, Gustin does not teach or suggest “scanning the front face and back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash.” Since Gustin does not scan the check or cash for processing the image, Gustin does not teach or suggest that this image is transmitted for processing. Since Gustin does not teach or suggest transmitting such images (as stated above), Doggett cannot process the scanned image (as stated above).

Furthermore, recognizing after the fact that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, is an indication of an improper application of hindsight considerations which is not proper criteria for resolving obviousness.

Hence, the Examiner fails to establish a *prima facie* case of obviousness for claims 1-11, 13-33, and 35-49. For at least these reasons, independent claims 1, 24, 40, and 45, as well as dependent claims 2-11, 13-23, 24-33, 35-39, and 46-49, are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

The foregoing is submitted as a full and complete Response to the non-final Office Action mailed November 3, 2005, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (202)508-5843 is respectfully solicited. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1458, and please credit any excess fees to such deposit account.

Dated: May 3, 2006

KILPATRICK STOCKTON LLP
607 14th Street, Suite 900
Washington, DC 20005-2018
Phone 202-508-5800
Fax 202-585-0045

Respectfully submitted,
By: Thomas A. Corrado

Thomas A. Corrado
Registration No. 42,439